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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,558	05/23/2001	John H. Clements	124172-1026	1760

7590 01/02/2003

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EXAMINER

SACKY, EBENEZER O

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
**09/863,558**

Applicant(s)  
**CLEMENTS ET AL.**

Examiner  
**EBENEZER SACKEY**

Art Unit  
**1626**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Nov 14, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other:  |

Art Unit: 1626

### **DETAILED ACTION**

This is in response to applicants amendment filed on 11/14/02.

Applicants have amended claims 1 and 5.

The rejection of claims 1-6 under 35 U.S.C. 112, first and second paragraphs have been withdrawn.

#### ***Response to Amendment***

Applicant's arguments filed 11/14/02 have been fully considered but they are not persuasive. Applicants argue that the Examiner has not met the criteria for establishing a prima facie case because Blank does not expressly disclose or suggest preparing hydroxyalkyl carbamate compositions by reacting an aqueous ammonium hydroxide and a six-membered cyclic carbonate as recited in claim 1 and that one of ordinary skill in the art would have no motivation to modify Blank to produce applicants hydroxyalkyl carbamate composition. The Examiner disagrees because Blank discloses that the instant method can be practiced using a

Art Unit: 1626

six-membered cyclic carbonate and an amine. See column 3, lines 59-61.

Ammonia given the broadest definition is an amine. Secondly, the reaction of a five-membered cyclic carbamate with ammonium hydroxide is also known. Therefore, one of ordinary skill in the art would expect that the substitution of one solvent for another solvent would result in the same outcome absent a showing of unexpected results. A comparative data by way of a 37 CFR 1.132 declaration between a reaction of a five-membered cyclic carbonate and a six-membered cyclic carbonate may be considered to overcome the rejection. Applicants next argue that Blank expressly states that reacting a six-member ring organic carbonates with a primary amine is not the preferred method because the six-member ring organic carbonates are expensive and difficult to prepare and thus such teaching away from the reference is a per se demonstration of lack of prima facie obviousness. This argument is unpersuasive because the reference did not specifically state that hydroxyalkyl carbamate cannot be prepared from a six-membered ring and an amine. It merely states that it is expensive and difficult. Such a statement does not obviate the rejection at hand.

Art Unit: 1626

Applicants next argue that, applicants would have no reasonable expectation at the time of their invention, that reacting a six-member ring organic carbonate with an aqueous ammonium hydroxide would produce a hydroxyalkyl carbamate that is easier to purify with superior handling characteristics. This is unpersuasive because applicants have not shown that the composition of Blank does not have superior handling characteristics or that the hydroxyalkyl carbamate of Blank is difficult to purify. Moreover, there is nothing of record to support applicants assertion. Applicants next argue that to establish a prima facie case, all limitations must be taught or suggested by the prior art, and that if an independent claim is nonobvious under 35 U.S.C. 103(a), then any depending claim therefrom is nonobvious. Blank discloses hydroxyalkyl carbamate composition as instantly claimed. The difference being the preferred use of a five-membered ring instead of a six-membered ring. For the reasons of record, the rejection under 35 U.S.C. 103 is being maintained.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1626

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (703) 305-6889. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for this Group is (703) 308-4556.

Art Unit: 1626

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

EOS

December 31, 2002

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Joseph K. McKane

Supervisory Patent Examiner

Art Unit 1626, Group 1600

Technology Center 1

*Alan L. Rotman*

ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600